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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/006,158	12/10/2001	William H. Wall	W6-19a	2016

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EXAMINER

CHATTOPADHYAY, URM

ART UNIT	PAPER NUMBER
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3738

DATE MAILED: 01/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/006,158

Applicant(s)

WALL, WILLIAM H.

Examiner

Urmi Chattopadhyay

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 22 December 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 2 and 8 is/are allowed.
- 6) ☒ Claim(s) 1, 3-7 and 9 is/are rejected.
- 7) ☒ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 December 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

## DETAILED ACTION

### *Request for Continued Examination*

1. The request filed on 12/22/03 for a Request for Continued Examination (RCE) under 37 CFR 1.114 based on Application No. 10/006,158 is acceptable and a RCE has been established. An action on the RCE follows.

### *Response to Amendment*

2. The amendment filed 12/22/03 has been entered as Paper No. 14. The changes to the abstract and claims have been approved by the examiner.

### *Claim Rejections - 35 USC § 112*

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 3 and 9 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

4. Claim 3 is indefinite because on line 19, "that provides fluid access between the rods" is referring to the passage formed by the tubular sheath. This is not possible because the specification discloses that the sheath prevents fluid access between the rods. It appears that that which is providing fluid access is one of the first and second ends, <sup>and</sup> ~~as~~ has been so interpreted for examination purposes. The examiner suggests changing "that provides" to --wherein one of said

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first and second ends provides-- to reflect the embodiment shown in Figure 1. Applicant is reminded that any clarification to this claim must be fully supported by the original disclosure.

5. Claim 9 recites the limitation "the balloon-expanded ring stents" in lines 11-12. There is insufficient antecedent basis for this limitation in the claim.

### *Claim Rejections - 35 USC § 103*

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1, 4-7 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Clouse in view of Lam.

Clouse discloses a blood vessel wall-defining device for repairing an aneurysm having all the claimed elements of claim 1, except for the ring stents and their respective limitations. See abstract for a structural frame being a combination of Figure 1 (structural skeleton 30) and Figure 2 (tubular membrane 40) and for the structural frame having a smaller unexpanded diameter and a larger expanded diameter than the blood vessel. See Figure 2 the structural frame (combination of 30 and 40) including a plurality of longitudinal support rods (46) being attached to a tubular sheath (41) for at least a portion thereof. Lam teaches an expandable coiled stent (claims 4 and 7; see Figures 5B-6B for the coiled stents being expandable to selected progressively uncoiled positions in order to meet the functional language of the structural frame being *capable* of being expanded to different breadths along its length and urging the structural

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frame toward engagement with the interior surface of an irregularly shaped vessel) having controlled expansion that can be locked into an expanded diameter in order to prevent collapse of the stent. See Figures 5A-5C and column 7, lines 15-28. It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to look to the teachings of Lam to modify the blood vessel wall-defining device of Clouse by replacing the expansible spring coil (48) disposed on the interior of the tubular sheath (41) with a plurality of the ratcheted ring stents longitudinally displaced from each other in order to have controlled expansion of the device along the longitudinal length of the device in addition to preventing the device from collapsing.

Claim 5, see column 3, lines 27-29 for longitudinal support rods (46) being flexible capable of performing the function of conforming to the shape of the vessel between the ring stents.

Claim 6, see Figure 2 for the structural frame (portions 30 and 46) surrounding the sheath (41) and for an arrangement such that the ring stents (replacing stent 48) would be biased against the structural frame (portions 30 and 46).

With respect to claim 9, see rejection to claim 1, *supra*. The plurality of elongated flexible support members (46) are arranged approximately parallel to one another and formed in a tubular array for insertion into a blood vessel of the human body (Figure 2). See column 7, lines 58-61 for the plurality of ring stents being structurally capable of being expanded in response to the inflation of a balloon catheter (thus making them balloon-expanded ring stents) and of meeting the functional language of urging the elongated flexible support members from their unexpanded diameter to the expanded diameter. Because claim 9 is a product claim, wherein the claimed invention is "a blood vessel wall defining device", and not a device and

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delivery system combination or method claim, the limitations of “balloon-expanded” and “in response to the inflation of a balloon catheter” are functional. In the current product claim, it does not matter how the ring stents are actually being opened, which relates to the method of using the product, as long as the stents are capable of being used in that way. The rings stents are certainly capable of being expanded by a balloon catheter, and thereby expand the flexible support members. The elongated flexible support members of Clouse are configured to support the blood vessel at the positions between the ring stents.

***Allowable Subject Matter***

8. Claims 2 and 8 are allowed.
9. Claim 3 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action.

***Response to Arguments***

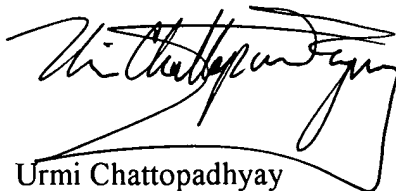
10. Applicant's arguments filed 12/22/03 have been fully considered but they are not persuasive. It appears that the amendments made to claims 1 and 9 were solely in response to the “Response to Arguments” section of the office action mailed 7/29/03. This section was simply to point out how applicant’s arguments were not persuasive. The section did not indicate limitations would deem the claims allowable over the prior art. Because applicant did not submit persuasive arguments with regards to the merits of the art rejections by pointing out disagreements with the examiner’s contentions or discussing the references applied against the

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claims, explaining how the claims avoid the references or distinguish from them, amended claims 1 and 9, and dependent claims, are still rejected under 103(a).


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ms. Urmi Chattopadhyay whose telephone number is (703) 308-8510 and whose work schedule is Monday-Friday, 9:00am – 6:30pm with every other Friday off. The examiner's supervisor, Corrine McDermott, may be reached at (703) 308-2111. The group receptionist may be reached at (703) 308-0858.

Should the applicant wish to send a fax for official entry into the file wrapper the Group fax number is (703) 872-9306. Should applicant wish to send a fax for discussion purposes only, the art unit fax number is (703) 308-2708.



Urmi Chattopadhyay

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BRUCE SNOW  
PRIMARY EXAMINER